The applicants 10/6/09 election of polyacrylate (it appears applicants meant polymethacrylate) and Group I in a previous restriction requirement is respectfully acknowledged.

Obviousness Type Double Patenting:

Claims 1,2, and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over all claims of copending Application No. 10/556,990 (US 2007/0137528 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because both teach a cement composition comprising a material having residual water absorption properties and capable of swelling (see claims to 10/556,990).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35 USC 102/103:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,2, and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2001 146457 (X reference from Int'l Search Report), ZA 9100876 (X reference from Int'l Search Report), Heathman et al. '990, Montgomery '012, '636, '503, '633, Darwin '158 or '343, Reddy et al. '841, Creel '802 A1, or Pageau '302 A1.

All of the above cited references teach a composition containing what applicants call a super absorbent polymer thus anticipating applicants claims (see claim of these respective prior art references). Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

See for example, claim 20 on p.5 for polymethacrylate and polyacrylamide for Heathman et al. '990 A1; col.7, lines 50-60 of Montgomery '012 teaching

polymethacrylate; Montgomery '636 col.8, line 13 teaching polymethacrylate; Note Darwin '158, for example teach imidized acrylic polymers which read upon non-soluble acrylic polymers or the broad polymer water absorbent material of applicants' claim 1; Reddy et al. '841 B2 teach polyacrylamide in claim 2; Creel et al. teach adding polyacrylamide or polyacrylate in claim 4; and Pageau teaches acrylic polymers in their claims for adding to cement (see claim 1).

The use of conventional additives such as retarders, accelerators (e.g. calcium chloride), dispersants, etc. is conventional in the cement art (See MPEP 2144).

Non-Elected Claims:

The non-elected claims 3-7 and 9-14 were restricted because the term cement "system" caused the restriction. System does not appear to be a statutory class of invention under 35 USC 101 as it is unclear whether a composition, method, apparatus, article? Applicants can have the system claims examined with claims 1,2, and 8 if they amend "system" (delete this term) and change to ---composition--- which is the invention of claim 1.

Claim 8 is indefinite under 35 USC 112 second paragraph because cement "slurry" lacks antecedent basis. Claim 2 is to a composition, not a slurry.

Applicants should also amend should amend "selected from the list consisting of--" to ---selected from the group consisting of in claims 11 and 14.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793